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REMARKS

Claims 1-52 are pending in the application prior to entering this amendment.

The Examiner's Amendment amends claims 2-4, 7, 10, 11, 15, 16, 28-30, 33, 36, 37, 41, 42 and 49, and cancels claims 1, 6, 14, 19, 27, 32, 40 and 45.

The Examiner's Amendment is unacceptable to the Applicant, and Applicant files an amendment and Request for Continued Examination to propose amended claim language.

The Applicant amends claims 1-13, 15-19, 21, 22, 24-39, 41-45 and 47-52.

Claims 1-52 remain in the application after entering this amendment.

The Applicant adds no new matter and requests reconsideration of all claims.

Allowable subject matter of claims 1-52

Claims 1-52 are allowable for the reasons provided in Applicant's Amendment dated January 31, 2006. Applicant requests that the Examiner reconsider and respond to these arguments in making a determination of allowability of claims 1-52 with the next Office Action.

Claim Language Objections (Ref. MPEP 2111.04)

The Examiner's Amendment deletes the words "adapted to" in claims 4, 7, 10 and 11, and deletes the words "wherein" and replaces the words "they result in" in claims 30, 33, 36 and 37 with the words "the instructions perform the steps of", apparently in reliance on MPEP 2111.04. The Applicant finds these amendments to be unacceptable. The Applicant does not agree that the usage of "adapted to", "wherein" or "they result in" in the claims suggests as optional any of the claim limitations recited therein. However, Applicant has replaced the words "adapted to" with "configured to", and has replaced the words "wherein" with "where" in order to facilitate bringing this case into allowance.

MPEP 2111.04 states that "the determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case." From the plain language of these claims, it is clear that the features recited in these clauses do not "simply express the intended result of a process step positively recited." (*Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 67 USPQ2d 1614,

1620) nor do they “describe the result of arranging the components of the claims in the manner recited in the claims.” (*Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018, 1023).

For example, amended claim 1 recites a device comprising:

- a network interface for coupling to a network; and
- a processor coupled with the network interface, wherein the processor is configured to:
 - transmit a call setup message to a called device through a network to establish a connection session for exchanging data;
 - receive from the called device a reply message;
 - analyze the reply message for inclusion of an attribute of the called device associated with the connection session;
 - infer from the reply message the attribute that is not included in the reply message; and
 - transmit data to the called device using the inferred attribute.

The components of claim 1 include a device comprising a network interface for coupling to a network; and a processor coupled with the network interface. Clearly, the features of the processor being configured to transmit, receive, analyze, infer and transmit may not merely be described as a result of arranging the network interface, network and processor in the device. Instead, these features clearly provide further limitations of the claimed embodiment and its functionality, in addition to those features which are described prior to the “configured to” clause.

The cases cited in MPEP 2111.04 do not stand for the proposition that all clauses including “wherein” or “adapted to” must be rejected as not providing limiting claim language. To the contrary, in *Hoffer v. Microsoft Corp* (74 USPQ2d 1481), the claim including a “whereby” clause was found to be limiting, such that it could not be ignored in the infringement analysis. Claims included in the present application are clearly distinguishable from those referenced in the cases cited in MPEP 2111.04 which were found to non-limiting, for the reasons discussed above.

Claims 12, 25, 28, 29, 31, 38, 41, 42 and 44 have been amended to clarify language in their preambles that is more consistent with the independent claims on which they depend.

CONCLUSION

For the foregoing reasons, the Applicant requests reconsideration and allowance of claims 1-52 of the application as amended. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,




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